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| 09/880,173   | 06/13/2001  | Tomoyuki Asano       | 09792909-5110       | 7206             |
| 26263      7590      07/09/2008<br>SONNENSCHN NATH & ROSENTHAL LLP<br>P.O. BOX 061080<br>WACKER DRIVE STATION, SEARS TOWER<br>CHICAGO, IL 60606-1080 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| POINVIL, FRANTZY   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 3692   |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/880,173

**Applicant(s)**

ASANO, TOMOYUKI

**Examiner**

Frantzy Poinvil

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3692

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17, 18, 20-22, 24-26 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 18, 20, 21, 22, 24, 25, 26, and 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/19/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 4/11/2008 have been fully considered. The Examiner's response is incorporated in the instant Office action.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 18, 20-22, 24-26 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al. (US Patent No. 6,560,581) in view of Hoffman et al (US Patent No. 5,613,012), or Kawakita (JP408287202A, November 1, 1996).

The Examiner's response to applicant's arguments is incorporated herein.

As per claims 17, 21 and 25, Fox et al disclose a system and method for accounting for a fee concerning service provided to a user by a service provider such as a merchant. The system and method comprise step or means for:

Receiving from the service provider a charge collection request based on a service request sent from the user to the service provider;

Informing the charge collection to the user based on the charge collection request received from the service provider and

Verifying validity of the charge based on the service request and digital signature based on the service request.

Applicant is referred to column 24, line 31 to column 26, line 2 of Fox et al.

Fox et al does not explicitly teach “when an objection to the fee is received from the user”, performing the verifying function. As per this limitation, the Examiner asserts that in most transactions, the consumer is usually presented with a statement acknowledging a purchase order or verifying that the costs or charges made by a merchant are correct before proceeding with making an actual payment. An objection to the costs, charges or fees would have then been made by the purchaser or buyer in the case of a conflict or dispute of the charges. Performing the same function in the system of Fox et al. would have been obvious to one of ordinary skill in the art in order to prevent disputes between all involved parties in the transaction.

*As per the limitation of “wherein information stored on the storage medium cannot be modified using software techniques”, the Examiner asserts that it would not make sense to alter a digital signature by the parties involved in the system of Fox et al and as such, it would not also make sense to alter the digital signature of the claimed invention. If the digital signature in the storage medium is modified, then digital signature will be doubtful or not credible. Thus, preventing the service requests and the digital signature in the storage medium from being modified would have been obvious to one of ordinary skill in the art to do at the time of the invention. The motivation would have been to allow the digital signature to remain genuine.*

As per the limitation of “when an objection to the fee is received from the user, verifying validity of the charge collection based on said service request data and digital signature data, said digital signature data being generated based on said service request data”...wherein... the digital signature is created from a name of the user and an account number of the user using the user terminal”, the Examiner disagrees with the applicant’s assertion that the system and method of

Fox et al is unsecured. The Examiner asserts that most transactions or business transactions being performed via a network or the Internet are usually secured or encrypted as a safety measure against hackers. In any event, securing or encrypting a transaction or message or file is well known in the art the time of the applicant's invention. Hoffman et al disclose a system and method for providing a tokenless identification system whereby a message is encrypted using a digital signature. The digital signature is created from a name of a user, biographical data (or user personal information) and an account number of the user. See column 33, lines 1-8 of Hoffman et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hoffman et al into Fox et al in order to provide a more secure system whereby a digital signature is tied to a user's information.

Applicant's representative argues that the prior art taken alone or in combination failed to teach or suggest the added features of the service request and the digital signature data for verifying are provided via "a removable storage device constituted by hardware , connectable to a user terminal ".

In response, the Examiner notes that the combination of Fox et al and Hoffman teach a service request and a digital signature for verifying data are provided via a storage medium connectable to a user terminal with the only difference being that the storage medium is not a removable storage device such as an IC card constituted by hardware, connectable to a user terminal. The Examiner further notes that in both the combination of Fox et al/Hoffman et al, and the claimed invention, a request and a digital signature for verification purposes are provided

via a storage medium connectable to a user terminal. The data being provided via software or a hardware device is not a patentable difference because the type of software or hardware the data is stored and/or obtained should not be the disputable inventive concept or invention. The type of storage device to store/capture the service request and digital signature is left as an obvious choice to the user. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fox et al and Hoffman et al to have the service request and digital signature data for verifying being provided via a removable storage such as an IC card in order to facilitate users with a portable device which can easily be carried by the user.

Applicant's representative argues that the combination of Fox and Hoffman fails to teach or suggest "the service request data and the digital signature data for verifying validity of the charge collection are provided via a removable storage device, constituted by hardware, connectable to a user terminal".

In response, the combination of Fox and Hoffman teaches all the claimed feature with the exception that there is not included a storage device. In absent of such a teaching, the Examiner had properly provided an obvious statement with a sound rationale and motivation for introducing a portable card in the combination of Fox and Hoffman. The applicant's representative disagrees and requests a prior art denoting this teaching. In response, the Examiner asserts that providing a datacard having a digital signature and for storing data is old and well known at the time of the applicant's invention as specifically noted on page 5, first paragraph of the applicant's specification.

Furthermore, Kawakita discloses a system and method for certifying IC card. Verification data are transmitted from the IC card to the a data center. See the provided document. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fox et al with the prior art technique used in the applicant's specification and/or the teaching provided by Kawakita to have the service request and digital signature data for verifying being provided via a removable storage such as an IC card in order to facilitate users with a secured portable device which can easily be carried by the user.

As per claims 18 and 20, 22 and 24, 26 and 28, in the combination of Fox et al, Hoffman, applicant's prior art and Kawakita, the service request and the digital signature are provided from the user and/or from the service provider. Note also column 24, line 31 to column 26, line 2 of Fox et al.

As per the limitation of "wherein the service requests and the digital signature for verifying are provided via a storage medium connectable to a user terminal". See Kawakita and the applicant's prior art description.

Furthermore, Fox et al are directed to a system and method for facilitating electronic payments between a consumer and a service provider or merchant providing goods/services to the consumer. In so doing, Fox et al teach that each entity, the consumer and the service provider is connected to a server via a communication system, registers to a certified binding

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server that all participants trust for verifying service requests and digital signature. See column 5, line 62 to column 6, line 20. Fox et al state:

“During the registration process (FIG. 1), the computing units 24(a)-24(c) at the participants 22(a)-22(c) are each programmed to generate and send a registration packet over the communication system (as represented by communication paths 30(a)-30(c)) to the credential binding server 28 at the trusted credential authority 26. The credential binding server 28 is programmed to produce unique credentials for each participant based upon their registration packets and to send the credentials 32(a)-32(c) back over the communication system (as represented by communication paths 34(a)-34(c)) to the multiple computing units 24(a)-24(c). These credentials are digitally signed by the trusted credential authority and will be used to identify and authenticate other participants during the commerce transaction. It is noted that the registration process requires interaction between each participant and the trusted credential authority”.

From this passage, it is clearly seen that the service requests and the digital signature for verifying are provided via a storage medium connectable to a user terminal. Fox et al further state:

“Each commerce transaction has at least one originating participant and one or more recipient participants. A computing unit 24(a) at the originating participant 22(a) is programmed to request and receive the credentials of all intended recipient computing units 24(b) and 24(c). The originating computing unit also verifies the credentials by checking the digital signature of the trusted credential authority. The originating computing unit 24(a) then generates commerce document(s) 36 and commerce instrument(s) 38 that are appropriate for the type of commercial transaction. The document(s) and instrument(s) are both encrypted and sent together over a communication path 40 to the computing unit 24(b) at the first recipient participant 22(b). The document(s) and instrument(s) are encrypted using appropriately different keys so that only the participants to whom the document(s) or instrument(s) pertains can decrypt them.”.

Thus, Fox et al teach verifying validity of the charge based on a service request and digital signature generated based on the service request and wherein the service requests and the digital signature for verifying are provided via a storage medium connectable to a user terminal.

Again, the only difference between Fox et al and the claimed invention is that the verifying function is done regardless an objection to the fee is received from the user.



Performing the verifying function only when an objection to the fee is received from the user would have been obvious to one of ordinary skill in the art to do when viewing the system and method of Fox et al in order to instantly clarify terms and conditions of payments between the different participants involved in a transaction so as to avoid future financial disputes.

The Examiner refers the applicant to column 24, line 31 to column 26, line 2 and a further reading of columns 22-30 of Fox et al for further teachings of the applicant's newly added limitations.

As per claims 28-31, the service request and the digital signature for verifying are provided from the service provider and the storage medium comprises hardware. See column 7, lines 8-25 and columns 22-30 of Fox et al. The hardware being an IC card is discussed above.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Frantzy Poinvil/  
Primary Examiner  
Art Unit 3692**

FP  
July 1, 2008